

REMARKS

Introduction

Claims 1 – 18 were originally pending in this case. Claims 1 – 10 have been cancelled. Claims 11 and 18 have been amended. Thus, Claims 11 – 18 remain in this application.

Objections To The Specification

The specification was objected to as failing to provide proper antecedent basis for the claimed subject matter. 37 CFR 1.75(d)(1) & MPEP § 680.01(o). More specifically, the Examiner noted that, “the bottom layer was not described as shoddy in the invention.” Applicants note that the claims form a part of the specification. Nevertheless, the written description has been amended to address this issue. No new matter has been added. Applicants respectfully submit that the present application complies in all respects with the requirements of 37 CFR 1.75(d)(1) and MPEP § 608.1(o).

Claim Rejections

35 U.S.C. § 102 – Anticipation

Claims 11-13 and 15 were rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. patent application publication 2004/0065507A1 to Jacobsen (the Jacobsen ‘507 application). A claim is said to be anticipated where each and every limitation of the claim can be found in a single reference. Independent claim 11 has been amended to more particularly describe the present invention. Claims 12 - 13 and 15 are ultimately dependent upon independent claim 11. In view of the amendments as explained in greater detail below, applicants respectfully submit that each and

every limitation of the independent claims in this case cannot be found in the Jacobsen '507 application. Accordingly, these rejections are respectfully traversed.

35 U.S.C. § 103 – Obviousness

Claims 14 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Jacobsen '507 application, as applied to claim 11, in view of the Fujita et al '045 patent. Additionally, claims 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Jacobsen '507 application, as applied to claim 11, in view of U.S. patent application publication 2004/0110438A1 to Thompson et al. (the Thompson et al. '438 application). Claims 14 and 16 – 18 are ultimately dependent upon independent claim 11. Independent claim 11 has been amended to more particularly describe the present invention. In view of the amendments as explained in greater detail below, applicants cannot agree with the Examiner that the invention claimed would have been obvious to one of ordinary skill in the art in view of these references. Accordingly, these rejections are respectfully traversed.

The Prior Art

The Jacobsen '507 Application.

The Jacobsen '507 application discloses a five-layer sound absorbing pad having a structure including a scrim, film, batt, film and scrim. More specifically, the Jacobsen '507 application discloses a five-layer sound absorbing pad where the interior batt layer is disposed between synthetic polymeric film layers. Jacobsen ¶[0029]. The interior batt layer is generally disclosed as a shoddy having natural and/or man-made fibers that may be woven or non-woven. Jacobsen ¶¶ [0030-31]. Additionally, the scrim layers and the film layers are constructed from the same materials, although

the scrim layers include a higher melting point than the adjacent film layers. Jacobsen ¶¶ [0040-43].

However, the Jacobsen '507 application does not disclose or suggest a method of manufacturing a composite shoddy for use as underlayment for a surface material in automotive applications that includes providing an organic base material that defines a shoddy bottom layer and a scrim material that defines a scrim top layer. Furthermore, the Jacobsen '507 application does not disclose or suggest the step of providing a primarily bituminous mastic material that defines a mastic middle layer wherein the shoddy bottom layer and the scrim top layer are bonded to opposite sides of the mastic middle layer, as described in independent claim 11, as amended.

The Fujita et al. '045 Patent.

The Fujita et al. '045 patent discloses a method for manufacturing an automotive interior component such as a door trim, rear side trim, or rear parcel shelf. The method includes providing a skin layer (50) and a cushioning layer (51) attached thereto within a mold (40) (FIG. 2). Extruded thermoplastic material is introduced to the mold and bonded to the cushioning layer (51). When cured, the thermoplastic material forms a rigid interior trim component for automotive applications where the skin layer (50) is visible from the interior of a vehicle. (FIG. 4).

However, the Fujita et al. '045 patent does not disclose or suggest a method of manufacturing a composite shoddy that includes providing an organic base material that defines a shoddy bottom layer and a scrim material that defines a scrim top layer where a primarily bituminous mastic middle layer is disposed therebetween where the scrim top layer is operatively engaged to the class-B side of a non-carpeted surface material, as described in independent claim 11, as amended.

The Thompson et al. '438 Application.

The Thompson et al. '438 application discloses an acoustic article 10 and method of manufacturing same utilizing isocyanate binders. More specifically, the Thompson et al. '438 application discloses an acoustic article 10 having recycled material 12 disposed between layers of material 14a and 14b, which may be scrim or carpeting. The recycled material 12 is described as a fiber scrap, including a shoddy, carpet scrap, natural fibers or foam, that is mixed with an isocyanate binder. Thompson ¶¶ [0013-15]. The acoustic article is manufactured by blending a mixture of an isocyanate binder and recycled material into a mass and then compressing mass into an article having a three dimensional contour.

However, the Thompson et al. '438 Application does not disclose or suggest a method of manufacturing a composite shoddy that includes providing an organic base material that defines a shoddy bottom layer and a scrim material that defines a scrim top layer where a primarily bituminous mastic middle layer is disposed therebetween where the scrim top layer is operatively engaged to the class-B side of a non-carpeted surface material, as described in independent claim 11, as amended.

The Present Invention

In contrast to that which is disclosed in the references of record in this case, the present invention as defined in independent claim 11 is directed toward a method of manufacturing a composite shoddy for use as underlayment for a surface material in automotive applications. The method includes providing an organic base material that defines a shoddy bottom layer having an engaging surface. The method further includes providing a primarily bituminous mastic material that defines a mastic middle layer having a first surface and a second surface opposite the first surface. The engaging surface of the shoddy bottom layer is then bonded to the first surface of the mastic

middle layer. The method further includes the step of providing a scrim material that defines a scrim top layer having a mastic contact surface and a receiving surface opposite the mastic contact surface wherein the receiving surface is adapted to operatively engage the class-B side of a non-carpeted surface material for use in automotive applications. The second surface of the mastic middle layer is then bonded to the mastic contact surface of the scrim top layer to form a tri-partite composite shoddy.

Argument

35 U.S.C. § 102

Claims 11-13 and 15 were rejected under 35 U.S.C. § 102(a) as being anticipated by the Jacobsen '507 application. Applicants respectfully submit that the method of manufacturing a composite shoddy defined in claims 11-13 and 15 is not disclosed or suggested by the Jacobsen '507 application. The Jacobsen '507 application discloses a five-layer sound absorbing pad where the interior batt layer is disposed between synthetic polymeric film layers, which are then sandwiched between two scrim layers. Furthermore, the Jacobsen '507 application does not disclose a method for manufacturing a tri-partite composite shoddy having a primarily bituminous mastic middle layer disposed between a scrim top layer and a shoddy bottom layer, but rather Jacobsen teaches a five-layer article having a middle layer constructed from a shoddy material and does not include a primarily bituminous mastic layer.

In contract to Jacobsen, the present invention includes the limitations of manufacturing a tri-partite composite shoddy by providing mastic middle layer that is primarily bituminous and a scrim top layer to operatively engage the B-side of a non-carpeted surface material as well as a shoddy bottom layer. Furthermore, the Jacobsen '507 application does not disclose or suggest the steps of

providing a scrim top layer that is adapted to operatively engage the B-side of a non-carpeted surface material for use in automotive applications, as required in independent claim 11, as amended. Accordingly, applicants respectfully submit that the structure required by newly amended independent claim 11 as discussed above cannot be found in the Jacobsen '507 application. Claims 12-18 are each ultimately dependent upon independent claim 11. It is respectfully submitted that the disclosure of the Jacobsen '507 application do not anticipate the invention as defined in these claims. For these reasons, applicants respectfully request that the rejection under § 102 be withdrawn.

35 U.S.C. § 103

A rejection based on §103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the present invention from the prior art. Furthermore, obviousness is not established by combining the basic disclosures of the prior art to produce the claimed invention absent a teaching or suggestion that the combination be made. Interconnect Planning Corp. v. Fiel, 774 F.2d 1132, 1143, 227 U.S.P.Q. (BNA) 543, 551 (Fed. Cir. 1985); In re Corkhill, 771 F.2d 1496, 1501-02, 226 U.S.P.Q. (BNA) 1005, 1009-10 (Fed. Cir. 1985). The test for combining references is what the combination of disclosures, taken as a whole, would have suggested to one of ordinary skill in the art. In re Simon, 174 U.S.P.Q. (BNA) 114 (CCPA 1972). Thus, it is not sufficient for an examiner merely to state that one cited reference teaches several of the limitations of a claim and another teaches several other limitations of a claim to support a rejection based on obviousness. As the Court of Appeals for the Federal Circuit has noted in the past, “[w]hen a rejection depends upon a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.” Ecolochem, Inc. v. Southern Calif. Edison, 56 U.S.P.Q. 2d 1065, 1073 (Fed. Cir. 2000). Specifically, the Examiner must show that a

person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings *in the particular manner claimed*. In re Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (emphasis added).

Here, there is simply no motivation to combine the Jacobsen '507 application with either the Fujita et al. '045 patent or the Thompson et al. '438 application. Moreover, there is no motivation to combine these prior art references in the manner claimed by the present invention. Even assuming that such a motivation existed, a combination of these references would not result in the method of manufacturing a tri-partite composite shoddy of the type described in independent claim 11, as amended.

Rather, the Jacobsen '507 application in connection with either the Fujita et al. '045 patent or the Thompson et al. '438 application skirt around, but do not suggest the claimed invention *as a whole*. See Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1383 (Fed. Cir. 1986). Specifically, the Jacobsen '507 application does not employ a primarily bituminous mastic middle layer operatively engaged to a scrim top layer and a shoddy bottom layer, but rather, teaches a five-layer pad having a shoddy middle layer disposed between two film layers and then sandwiched between two scrim layers. On the other hand, the Fujita et al. '045 patent teaches away from Jacobsen by advocating the manufacture of a rigid trim component via extrusion of a thermoplastic material onto a skin layer that defines the class-A surface of a vehicle. Likewise, the Thompson '438 application teaches away from Jacobsen by the advocating the manufacture of an acoustic article by forming a mixture of an isocyanate binder and scrap material into a shoddy that is compression molded into a three dimensional contour. Accordingly, the teachings these diametrically opposed references would have to be reconstructed or rearranged to change their operations if they were to be combined.

There is a fundamental axiom in patent law that if a reference must be reconstructed or rearranged to change its operation to meet the applicants' claim, that modification of the reference is inappropriate and cannot stand. It is respectfully submitted that the Examiner is picking and choosing elements from the dissimilar methods disclosed in the Jacobson '507 application, the Fujita et al. '045 patent and the Thompson et al. '438 application and combining these elements by restructuring them, using hindsight and the applicants' own disclosure, to conclude that the claimed invention is obvious.

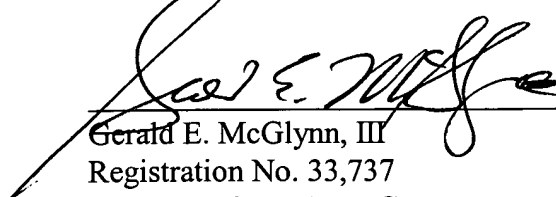
Neither the Jacobsen '507 application, nor the Fujita et al. '045 patent nor the Thompson et al. '438 application teach or suggest a method of manufacturing a composite shoddy including the steps of providing a shoddy bottom layer, a mastic middle layer and a scrim top layer where the mastic middle layer is primarily bituminous and disposed between the shoddy bottom layer and the scrim top layer to define a tri-partite shoddy where the scrim top layer is adapted to operatively engage the B-side of a non-carpeted surface material in an automotive application, as required independent claim 11, as amended. Thus, applicants respectfully submit that the disclosures of each of these references would have to be improperly modified to meet the limitations of independent claim 11, as amended.

Claims 12-18 are ultimately dependent upon independent claim 11 and add further perfecting limitations which cannot be found in, nor are they suggested by, the Fujita et al. '045 patent, which discloses a method of manufacturing a rigid substrate interior trim component, or the remaining prior art references. However, even if they did, they could only be applied through hindsight after restructuring the disclosure of the prior art in view of applicants' invention. A combination of the prior art in this way to derive applicants' invention would, in and of itself, be an invention.

Conclusion

In view of the above, it is respectfully submitted that claims 11-18 are patentably distinguishable over the prior art of record. Accordingly, allowance of claims 11-18 is respectfully solicited at this time.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gerald E. McGlynn, III", is written over a horizontal line.

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